

REMARKS

Applicants respectfully request further examination and reconsideration in view of the instant response. Claims 1 and 38-76 are pending. Claims 1 and 38-76 are rejected. Claims 1 and 56 are amended herein. No new matter has been added. Support for the instant amendments can be found at least at page 10, lines 1-20, and page 48, lines 1-15.

35 U.S.C. §101

The Office Action mailed March 2, 2010, hereinafter referred to as the "instant Office Action," states that Claims 1 and 38-76 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Claims 56-76

Specifically, the instant Office Action states that Claims 56-76 can be representative of a single computer system that implements the functionality of several location Managers, portals and service providers. The instant Office Action asserts that these functionalities may be implemented by software applications on the single computer and therefore the claim is software per se and non-statutory.

Applicants submit that Claim 56 has been amended to recite (emphasis added):

A computer system for providing streaming content to a client device, said system comprising:
a plurality of service location managers, wherein said plurality of service location managers are hardware nodes;
a plurality of service providers, each service provider capable of performing a service on an item of streaming input content to produce said streaming content, wherein said plurality of service providers are hardware computer systems; and
a portal providing a first point of contact for said client device, said portal for receiving from said client device a request for performance of said service on an item of streaming input content, said portal for selecting a service location manager to which to provide said request from said plurality of service location managers, said service location manager for receiving said request from said portal and for selecting a service provider from said plurality of service providers and informing said service provider of said assignment to perform said service on said streaming input content to produce said streaming content and for providing said service provider with information to transfer communication from said portal to said service provider for providing said streaming content to said client from said service provider, wherein said portal is a hardware node.

Applicants respectfully submit that Claim 56, as amended, is directed to a hardware system and is not software per se. Therefore Applicants submit that Claim 56 is directed to statutory subject matter.

Applicants note that Claims 57-76 depend from Claim 56, therefore Applicants submit that Claims 56-76 overcome the rejection under 35 U.S.C. §101.

Claims 1 and 38-55

Specifically, the instant Office Action states that Claims 1 and 38-55 do not fall within one of the four statutory categories of invention and either must be

(1) tied to a particular machine, or (2) transform the underlying subject matter to a different state or thing.

Applicants submit that Claim 1 has been amended to recite (emphasis added):

A computer implemented method for managing a streaming media service, said method comprising:

receiving a request for a streaming media service from a client at a computer processor, said streaming media service comprising a media service component;

selecting a service location manager at said computer processor to which to provide said request from a plurality of service location managers;

selecting, at said computer processor, a service provider to which to assign said media service component from a plurality of service providers of a network, wherein said selecting said service provider is performed by said service location manager;

informing, at said computer processor, said service provider of said assignment to perform said media service component, causing said service provider to prepare to perform said streaming media service on streaming media; and

providing, at said computer processor, said client information for locating and contacting said service provider to receive said streaming media from said service provider without utilizing said service location manager.

Applicants respectfully submit that Claim 1 as amended, is tied to a particular machine and therefore overcomes the rejection. Applicants note that Claims 38-55 depend from Claim 1, therefore Applicants submit that Claims 1 and 38-55 overcome the rejection under 35 U.S.C. §101.

35 U.S.C. §103(a)

Request for Clarification – Incomplete Grounds of Rejection Given for Claim 1

Applicants respectfully note that the Office Action Summary of the instant Office Action states that Claims 1 and 38-76 stand rejected. However, Applicants respectfully submit that the Detailed Action does not provide a proper ground of rejection for Claim 1.

“The examiner’s action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made” (emphasis added; 37 CFR §1.104(b)). “In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command” (37 CFR §1.104(c)(2)). In particular, “[w]here a claim is refused for any reason relating to the merits thereof it should be “rejected” and the ground of rejection fully and clearly stated” (emphasis added; MPEP §707.07(d)).

Page 4 of the instant Office Action, in the Detailed Action, states that “Lume does not explicitly disclose: • providing said client information for locating and contacting said service provider to receive said streaming media from said service provider without utilizing said service location manager.” Applicants note that the Detailed Action does not include any discussion of which reference does disclose “providing said client information for locating and contacting said service

provider to receive said streaming media from said service provider without utilizing said service location manager.”

Therefore, Applicants respectfully submit that the instant Office Action is not “complete as to all matters” as required under CFR 37 §1.104(b). Moreover, Applicants respectfully submit that any subsequent Office Action, if necessary, should indicate the allowance of Claim 1 or should be non-Final as the rejection of Claims 1 has not yet been completely addressed.

Claims 1 and 38-76

The instant Office Action states that Claims 1 and 38-76 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,529,950 by Lumelsky et al., hereinafter referred to as “Lumelsky” in view of U.S. Patent No. 5,341,477 by Pitkin et al., hereinafter referred to as “Pitkin.” Applicants have reviewed Lumelsky and Pitkin and respectfully submit that the claimed embodiments as recited in Claims 1 and 38-76 are not anticipated by Lumelsky for at least the following rationale.

Independent Claim 56 have features similar to independent Claim 1. Claims 38-55 depend from independent Claim 1. Claims 57-76 depend from independent Claim 56. Hence by demonstrating that Claim 1 is patentable over Lumelsky in view of Pitkin, it is also demonstrated that Claims 38-76 are patentable over Lumelsky in view of Pitkin.

A. Pitkin teaches away from Applicants' claimed features.

Applicants respectfully submit that “[i]t is improper to combine references where the references teach away from their combination” (emphasis added; MPEP 2145(X)(D)(2); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). Appellant respectfully notes that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” (emphasis in original; MPEP 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). “[A] reference will teach away if it suggests that the line of development flowing from the reference’s disclosures is unlikely to be productive of the result sought by the applicant. *In re Gurley*, 31 USPQ2d 1130 (Fed. Cir. 1994).”

“As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is

a question of law based on underlying factual inquiries” including “[a]scertaining the differences between the claimed invention and the prior art” (MPEP 2141(II)). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious” (emphasis in original; MPEP 2141.02(I)).

Additionally, MPEP §2141.02 VI provides, “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” (emphasis added; MPEP 2141.02 VI, *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 [Fed. Cir. 1983], *cert. denied*, 469 U.S. 851 [1984]).

Applicants respectfully note that “[t]he prior art reference (or references when combined) need not teach or suggest all the claim limitations. However, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art” (emphasis added; MPEP 2141[III]).

Applicants respectfully submit that embodiments of Applicants’ Claim 1 as a whole would not have been obvious, and therefore the instant Office Action does not satisfy the requirements for a rejection of Claim 1 under 35 U.S.C. §103(a). In particular, Applicants respectfully submit that the instant Office

Action fails to explain the differences between Lumelsky, Pitkin and Applicants' claimed features, in which Pitkin fail teaches away from features of Applicants' Claim 1. Moreover, Applicants respectfully submit that the instant Office Action fails to explain why these differences would have been obvious to one of ordinary skill in the art.

Applicants note that Claim 1 recites, with similar features in Claim 56 (emphasis added):

A computer implemented method for managing a streaming media service, said method comprising:

receiving a request for a streaming media service from a client at a computer processor, said streaming media service comprising a media service component;

selecting a service location manager at said computer processor to which to provide said request from a plurality of service location managers;

selecting, at said computer processor, a service provider to which to assign said media service component from a plurality of service providers of a network, wherein said selecting said service provider is performed by said service location manager;

informing, at said computer processor, said service provider of said assignment to perform said media service component, causing said service provider to prepare to perform said streaming media service on streaming media; and

providing, at said computer processor, said client information for locating and contacting said service provider to receive said streaming media from said service provider without utilizing said service location manager.

Applicants note that the instant Office Action states that Lumelsky does not explicitly disclose all features of Claim 1 (instant Office Action page 4). No other reference or rationale is cited for this deficiency. The instant Office Action also states that Lumelsky does not explicitly disclose all features of Claim 56

(instant Office Action page 10). Pitkin is relied upon to overcome the shortcomings of Lumelsky in regard to Claim 56.

Specifically, Applicants assert that Pitkin teaches away from “selecting, at said computer processor, a service provider to which to assign said media service component,” “informing, at said computer processor, said service provider of said assignment to perform said media service component,” and “causing said service provider to prepare to perform said streaming media service on streaming media,” as disclosed by Claim 1.

First, Applicants understands Pitkin to disclose “Based upon the policy, the broker thus suggests to the client a server which is best able to satisfy the client's service request.” (emphasis added; Pitkin, col. 2 lines 45-47).

Applicants respectfully submit that “the broker thus suggests to the client a server,” as disclosed by Pitkin, teaches away from “selecting, at said computer processor, a service provider to which to assign said media service component,” as disclosed in Applicants’ Claim 1.

Second, Applicants also understand Pitkin to disclose, “the client then requests the service from the recommended server, and the server is responsible for granting the request only if the server currently has the required capacity available for that service.” (emphasis added; Pitkin, col. 2 lines 51-55).

Applicants respectfully submit that “the server is responsible for granting the request,” as disclosed by Pitkin, teaches away from “informing, at said computer processor, said service provider of said assignment to perform said media service component,” and “causing said service provider to prepare to perform said streaming media service on streaming media,” as disclosed by Claim 1.

Therefore, Applicants submit that it would be improper to combine Lumelsky with Pitkin to teach Applicants’ claimed features. Therefore, Applicants respectfully submit that the combination of Lumelsky and Pitkin do not constitute a prima facie case of obviousness to render Claims 1 and 38-76 unpatenable.

B. Combining Pitkin with Lumelsky will change the principle of operation of Pitkin

Applicants respectfully note that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” (emphasis in original; MPEP 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). Moreover, Applicants note that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the

references are not sufficient to render the claims *prima facie* obvious” (emphasis added) (MPEP 2143.01; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Moreover, “[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed amendment” (emphasis added) (MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

As cited above Applicants understand Pitkin to disclose “based upon the policy, the broker thus suggests to the client a server which is best able to satisfy the client's service request” and “the client then requests the service from the recommended server, and the server is responsible for granting the request only if the server currently has the required capacity available for that service.”

Applicants also understand Pitkin to disclose, “Since the server makes the final determination of whether it has the available capacity to provide the requested service, there is no risk of overloading a server because the broker has out of date status information--for example, as when a server becomes busy subsequent to its last status message transmitted to the broker.” (Pitkin, col. 2 lines 55-62).

In other words, Pitkin discloses the “broker” is to “suggest” a server to the client and “the server is responsible for granting the request” and the principle of

operations of Pitkin is “the server makes the final determination of whether it has the available capacity to provide the requested service.”

Applicants respectfully submit that combining Pitkin with Lumelsky to teach “selecting, at said computer processor, a service provider to which to assign said media service component,” “informing, at said computer processor, said service provider of said assignment to perform said media service component,” and “causing said service provider to prepare to perform said streaming media service on streaming media,” as disclosed by Claim 1, will substantially change the principle of operation of Pitkin as the server will no longer make the determination to provide the requested service. Thus, Pitkin would be rendered unsatisfactory of its intended purpose.

Therefore, Applicants submit that it would be improper to combine Lumelsky with Pitkin to teach Applicants’ claimed features. Thus, Applicants submit that a prima facie case of obvious has not been met and Claims 1 and 38-76 are patentable over Lumelsky in view of Pitkin and overcome the rejection under 35 U.S.C. § 103(a).

CONCLUSION

Based on the arguments presented above, Applicants respectfully assert that Claims 1 and 38-76 overcome the rejections of record, and therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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